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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/580,563

05/30/2000

Kevin Peter Picott

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1726

21171

7590

09/19/2006

STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

GOOD JOHNSON, MOTILEWA

ART UNIT

PAPER NUMBER

2628

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/580,563	Applicant(s) PICOTT, KEVIN PETER	
	Examiner Motilewa Good-Johnson	Art Unit 2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>09/13/2006</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/28/2006 has been entered.

Allowable Subject Matter

2. Prosecution on the merits of this application is reopened on claims 9-18, 21 and 22 are considered unpatentable for the reasons indicated below:

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 and 5-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-3 and 5-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a method, which merely manipulates an abstract idea, which is non-statutory subject matter.

Claims that are noted above as being rejected but that are not specifically cited below are rejected based on their dependency on rejected independent claims as incorporating the errors of those claims and not imparting any features leading to statutory subject matter.

Regarding claim 1-3 and 5-26, the claims recite "a method, comprising: evaluating a dependency graph of a graphics creation process . . . passing a pointer to an algorithm . . . and executing the algorithm as part of an evaluation . . .". The disclosed invention has a practical application, e.g., the executing of an algorithm. The disclosed invention is within the technological arts. However, the steps of the method of the practical application do not produce a useful, concrete and tangible result, i.e. a created graphic displayed on a display. Therefore, in order to determine if the process is statutory, one must determine what the computer does to achieve a practical application. A process that merely manipulates an abstract idea is non-statutory despite the fact that it might inherently have some usefulness. For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea. Examiner finds no limitation to a practical application for the claimed method. As an illustration of the lack of limitation to a particular, practical application, the method claimed by Applicant could be accomplished by mental steps of one of ordinary skill in the art aided by pencil and paper. Thus, a claim that recited a computer that solely calculates a mathematical formula or a computer that solely stores a mathematical formula is not directed to the type of subject matter eligible for patent protection. Therefore, when taken as a whole, the claim covers every substantial practical

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application thereof for the execution of a passed algorithm. See *Benson*, 409 U.S. at 67, 175 USPQ at 675-676, and *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754.

Regarding claim 21, the claim recites “a data structure provided on computer readable storage controlling a computer in association for evaluating . . .” The data structure not embodied in computer-readable media are descriptive material and not statutory due to the incapability of causing functional change in the computer. Therefore the data structure of claim 21 as recited does not define any structural and functional interrelationship. However a computer-readable medium encoded with a data structure defines the data structure program and other functional interrelationship of a computer software and hardware component of a computer to permit the data structure’s functionality.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Motilewa Good-Johnson whose telephone number is (571) 272-7658. The examiner can normally be reached on Monday, Tuesday and Wednesday 9:00 AM - 6:30 PM.

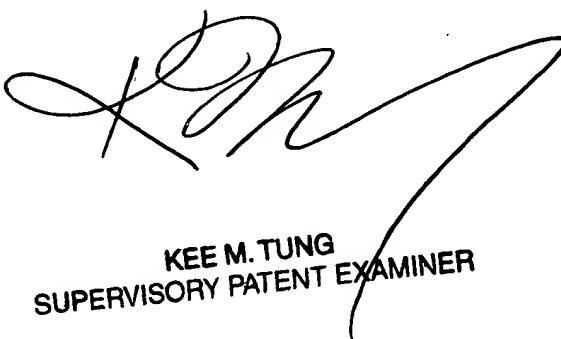
If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Kee Tung can be reached on (571) 272-7794. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Motilewa Good-Johnson
Examiner
Art Unit 2628

mgj



KEE M. TUNG
SUPERVISORY PATENT EXAMINER